

OCT 19 2006

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE TRANSMITTED TO THE U.S. PATENT AND TRADEMARK OFFICE (FAX NO. (571) 273-8300) ON THE DATE INDICATED BELOW:

Date of Transmission: 10/18/2006By: 

Stuart Whittington

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Michael Hosey

Atty. Docket No: 50065.00011

Appln. No.: 10/719,537

Group Art Unit: 2854

Filed: 11/20/2003

Examiner: Hinze, Leo T.

Title: DISPLAY DEVICE WITH HINGED STAND

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Pursuant to Appellant's Notice of Appeal filed on July 18, 2006, Appellant presents this Brief in appeal of the Final Rejection dated April 18, 2006.

I. REAL PARTY IN INTEREST.

Michael Jackson Hosey is the real party of interest.

II. RELATED APPEALS AND INTERFERENCES.

There are no related appeals or interferences before the Board of Patent Appeals and Interferences or related judicial proceedings known to Appellant, the Appellant's legal representatives, or assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

10/19/2006 TL0111 00000005 10719537

02 FC:2402

250.00 0P

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537

III. STATUS OF CLAIMS.

Claims 1-22 are all the claims pending in the application and claims 1-22 stand finally rejected and are the claims subject to this appeal. Claims 1-22 are reproduced in attached Appendix A.

IV. STATUS OF AMENDMENTS.

No amendments to the application have been presented since the final rejection dated April 18, 2006. A response requesting reconsideration of the final rejections was submitted on July 11, 2006 and was indicated as being "unpersuasive" in the Advisory Action dated 8/15/2006. This appeal now follows.

V. SUMMARY OF CLAIMED SUBJECT MATTER.

Embodiments of the instant invention relate to display devices having a clip which can pivot and act as a stand for the display device. (Specification, pg. 1, par. 1; claims 1, 6, 12 and 16; Figs. 1-5). In certain embodiments, referring to Figs. 1-4, a time keeping device 100 may include a casing section 102 and an attachment section 104 connected to the casing section 102 at a hinge section 106 such that the attachment section 104 and/or casing section 102 can rotate about an axis. (Spec. pg. 3, par. 0017).

Casing section 102 may contain and protect an electronic display device 108, such as an LCD, which has various modes for displaying a plurality of information related to time, altitude, barometric pressure, chronograph, compass direction, alarm information and/or temperature. In various embodiments, device 100 may include buttons 110-116 to effect calibrations, settings

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537

and or display features. (Spec. pg. 3, par. 0017-0018, pgs. 4-5, par. 0021 and 0023; see also claims 2, 3, 5, 8, 13 and 18).

Hinge section 106 connects casing section 102 to attachment section 104 that allows device 100 to be attached to and removed from an object of interest. In various embodiments, attachment section 104 is formed as a clip such as a carabiner clip (Spec. pgs 5-6 pars. 0024-0025; and claims 1, 4, 6, 9 and 15) and hingedly connected to casing 102 in a manner that display device 1080 may be kept in an upright position when device 100 is placed on a horizontal surface such as a desk or table. (Spec. pg. 6, par. 0025; Fig. 5).

In certain embodiments, device 100 may comprise an MP3 player, a cell phone, a personal digital assistant, a calculator, a digital camera or a radio communication device (spec. pg. 3, par. 0016 and claims 11, 15, 19, and 21-22) and casing 120 may include a temperature sensor that measures the temperature external to device 100 for presentation on display device 108 (Spec. pg. 4, par 0021 and claims 5, 10).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL.

The issues for consideration on this Appeal are:

A. Whether claims 1-3, 6-8 and 10-15 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,781,512 to Pantet in view of U.S. Patent 5,540,367 to Kauker?

APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537

B. Whether claims 5, 8, 10 and 18 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Pantet in view of Kauker in further view of U.S. Patent 6,751,164 to Sekiguchi?

C. Whether claims 11, 15 and 19-21 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Pantet in view of Kauker in further view of U.S. Patent 6,801,476 to Gilmour? and

D. Whether claim 22 is properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Pantet in view of Kauker in further view of U.S. Patent 4,022,014 to Lowedenslager?

VII. ARGUMENT.

A. APPELLANT'S CLAIMS ARE NOT RENDERED UNPATENTABLE BY THE COMBINATION OF PANTET IN VIEW OF KAUKER.

LEGAL STANDARD

It is well established that *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537

motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

ARGUMENT

All rejections set forth in the 4/18/06 Final Office Action rely on the combination of Pantet and Kauker. Appellant respectfully submits the present rejections are improper because (1) there is no proper motivation to combine these references as proposed; and (2) even when combining the teachings of the cited references, the limitations present in Appellant's independent claims are not disclosed or suggested.

(1) THERE IS NO PROPER MOTIVATION TO COMBINE REFERENCES

Pantet discloses a conventional watch 1 and a suspension and support device 2 on which watch 1 is mounted in a removable manner. (Col. 3, ll. 22-25). Suspension and support device 2 (illustrated in detail in Figs. 3-5) includes a first part 11 and a second part 12. First part 11 is for removably holding the outer casing 3 of pocket watch 1. Second part 12 has the general shape of a substantially flat and rectangular ring and is connected to first part 11 via hinge 13. (Col. 3, ll. 38-66). Both Pantet parts 11 and 12 are configured so a conventional watch 1 may be suspended from a chain as well as enable the watch to be placed on a piece of furniture and so that the watch requires little space, for example when it is placed in a pocket of a garment. (Col.

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537

4, ll. 7-10). Part 12 (rectangular ring) is shaped to form a suspension element allowing a snap hook 40 of a small suspension chain 41 to secure it. (Col. 4, ll. 11-14). Pantet discloses throughout that a main advantage/premise of its invention is to reduce the “bulky” nature of previous pocket and table watch configurations so that it is more convenient to carry in a pocket of a garment. (Col. 1, ll. 61-62; col. 2, ll. 15-15, 24-25, 65-66; and col. 4, ll. 8-9). Appellant lastly notes that Pantet, which discloses and claims only minor variations to many years of previous pocket watch configurations was issued as a patent as late as 1998.

The 4/18/06 Final Office Action alleges it would be obvious for the skilled artisan to modify Pantet with the carabiner clip of Kauker to allow a watch “to be attached to a wide variety of belongings.....” (Final Office Action pg. 3). However, as described above, Pantet is devoted to a very specific application for chain-based pocket watches and attaching pocket watches to a suspension chain 41 that already includes a “snap hook” 40. Accordingly, Pantet teaches away from the proposed motivation that “it to be easily attached to a wide variety of objects.” Furthermore, Kauker explicitly teaches that the “pocket watch passed out of vogue in the early 20th century” and that other “practical and ornamental ways to mount and carry watches” are needed other than chain pocket watches and wrist watches. (Col. 1, ll. 10-26). Accordingly, the very premise of each reference teaches away from combining with the other.

Additionally, Appellant respectfully submits that the proposed modification of the Pantet pocket watch with the carabineer clip of Kauker (which is specifically designed as an alternative for traditional chained pocket watches and wrist watches) is expressly contrary to the teachings

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537

of Pantet because Pantet discloses that a primary goal of its invention is to reduce the "bulky" nature of previous prior art pocket and table watch configurations so that the resultant product can fit easily or conveniently into a pocket of a garment. (Col. 1, ll. 61-62; col. 2, ll. 15-15, 24-25, 65-66; and col. 4, ll. 8-9). To this end, Pantet shows, by virtue of Fig. 1 and 3 that its ring 12 (cited in the Office Action as an "attachment section," should be relatively small and not cumbersome, while still be able to provide vertical support (table top configuration), to be manageable to carry around in one's pocket.

In direct contrast to Pantet, Kauker teaches that chain mounted pocket watches are no longer used or desirable and proposes a new type of watch carrier 10. Referring to Figs. 1-9 of Kauker, watch carrier 10 includes an elongated hanger 14 which appears as large or larger than the watch 20 itself. Thus the proposed combination of Kauker hanger 14 with Pantet pocket watch 1 and casing 11 appears to be expressly contrary to the teachings of Pantet because such a modification would apparently double the weight/bulk of the resultant pocket watch. Further Pantet teaches that its suspension and support device 2 is specifically designed for attaching to a pocket watch chain 41 which already has its own clip 40. In contrast, Kauker discloses that "Ring 23 has been used in the past as the traditional place for attachment of gold or other precious metal chain when the watch was carried in the traditional manner in a gentlemen's vest. Employing this invention, the ring 23 is NOT used. (Col. 2, ll. 43-49; emphasis added). Consequently, the alleged suggestion that it would be obvious to form Pantet ring 12 as a clip

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537

(such as Kauker hanger 14) appears to be in direct contradiction to the express teachings of both references.

Lastly, the motivation for modifying the pocket watch of Pantet to include a carabineer clip is allegedly to enable a watch "to be easily attached to a wide variety of objects." However, Kauker already apparently teaches a watch hanging device 10, which includes a clip 14 that could "be easily attached to a wide variety of objects." Accordingly, there does not appear to be any motivation for the skilled artisan to redesign and reconstruct the device of Pantet to result in a watch that is easily attached to a wide variety of objects because Kauker already discloses such a device without need for redesigning the device disclosed by Pantet. Respectfully, the Office Action rejections appear to conveniently select elements from the respective references when it suits the instant rejections while simultaneously entirely ignoring the context in which these elements are disclosed when it weighs against the proposed combination.

Because there is no objective reason for combining/modifying Pantet with Kauker as suggested in the Office Action, and in fact since the cited references provide multiple reasons weighing against the alleged motivation for making such a combination/modification, Appellant submits *prima facie* obviousness has not been established with respect to any the rejections in this appeal which all rely on the combination of Pantet and Kauker. Instead, it appears that the motivation to modify Pantet with the clip of Kauker is based solely in an attempt to reconstruct Appellant's claims in piecemeal fashion using the improper hindsight of Appellant's disclosure as a guide. Such hindsight is impermissible and does not establish *prima facie* obviousness.

RECEIVED
CENTRAL FAX CENTER

OCT 19 2006

APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537

(2) THE COMBINATION OF PANTET AND KAUKER FAIL TO TEACH OR SUGGEST THE LIMITATIONS PRESENT IN APPELLANTS CLAIMS

Even assuming it would be proper to combine the teachings of Pantet and Kauker as set forth in the Office Action (*arguendo*), Appellant respectfully submits that the resulting combination still fails to teach or suggest the limitations present in Appellant's independent claims. For example, Appellant's claim 1 recites:

A timepiece comprising:

a casing;

a display device secured by the casing; and

a clip pivotally attached to the casing; and

wherein the clip is configured to be attachable to an object of interest and wherein the clip is configured to pivot in a position to maintain the display device in a substantially upright position when the attachment section is placed on a substantially horizontal surface.

It is respectfully submitted that even the combination of Pantet and Kauker fails to teach or suggest *a clip pivotally attached to the casing, the clip configured to be attachable to an object of interest, the clip configured to be pivoted in a position to maintain the display device in a substantially upright position when the clip is placed on a substantially horizontal surface (or form a stand for the apparatus as recited in claim 16).*

Kauker Figs. 1 and 2 show a watch 20 including a conventional crown 22 and a ring 23 (traditionally used for connecting to pocket watch chains but NOT used in Kauker's invention). A separate D-ring 21 is attached (via screws or brazing) to a side of watch 20 (or watch casing 20c) near the bottom or "6 o'clock position" of the case. (Col. 2, ll. 40-43). A hanger 14 is connected to watch D-ring 21 via a unitary double loop connector strap 15. (Col. 2, ll. 37-39).

APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537

The (strap) connector 15 is unitary and both ends are formed with loops or tubular-openings so that one end encircles an end 14a of hanger 14 and the other end encircles the D-ring 21 secured to the case 20c of watch 20.

Accordingly, even when combining the teachings of Pantet with Kauker, the most that the resulting combination could produce appears to be the suspension and support device 2 of Pantet suspended by hanger 14 Kauker via the strap connector 15. For example, the Kauker strap connector 15 would be attached to the Pantet cylindrical bar 28 and/or thicker adjacent portions 29 (Fig. 3) and the Kauker hanger 14 would be entirely separate (by the extension of the strap connector 15) from the Pantet suspension and support device 2.

Therefore it is respectfully submitted that, Pantet and Kauker, taken alone or in combination, do not teach or suggest *a clip which forms a stand (or maintains a display device in a substantially upright position)* as recited in Appellant's independent claims 16 (or 1) or similar limitations which are present in Appellant's independent claim 6 .

Because Pantet and Kauker, taken alone or in combination, fail to teach or suggest at least the foregoing limitations of Appellant's claims, *prima facie* obviousness has not been established with respect to any of claims rejected based on the combination of Pantet and Kauker. In view of the foregoing, Appellant respectfully requests that the Board overturn the §103 rejection based on the combination of Pantet and Kauker.

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537

**B-D. APPELLANT'S CLAIMS ARE NOT RENDERED UNPATENTABLE BY
THE COMBINATION OF PANTET IN VIEW OF KAUKER IN FURTHER
VIEW OF SEKIGUCHI, GILMOUR OR LOWDENSLAGER.**

The secondary references Seckiguchi, Gilmour or Lowdenslager are cited to address additional limitations present in Appellant's dependent claims 5, 8, 10 and 18 (Sekiguchi), claims 11, 15 and 19-21 (Gilmour) and claim 22 (Lowdenslager), for which the combination of Pantet and Kauker admittedly fails to teach or suggest. Because all of these rejections rely on the combination of Pantet and Kauker, which is believed to be improper for the reasons discussed above, and because the additional secondary references fail to remedy the noted deficiencies of the Pantet and Kauker combination, Appellant does not address the properness of combining or the resultant combination of these additional secondary references.

It is respectfully submitted that a *prima facie* case of obviousness has not been established with regard to any of the rejections relying on Sekiguchi, Gilmour or Lowdenslager since these references fail to remedy the deficiencies of the proposed combination of Pantet and Kauker described previously. Namely, since there is no proper motivation for combining Pantet and Kauker in the first place, and because even when combining Pantet and Kauker all of the limitations present in Appellant's independent claims are not disclosed or suggested, *prima facie* obviousness has not been established with respect to any of Appellant's claims.

Since Pantet, Kauker, Sekiguchi, Gilour and/or Lowdenslager, taken alone or in any combination, fail to disclose or suggest all the elements of Appellant's claims, the §103

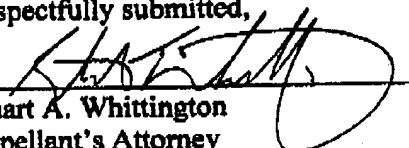
APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537

rejections in the Final Office Action of 4/18/06 are believed to be improper and Appellant respectfully requests the Board is to overturn these rejections.

VIII. CONCLUSION.

It is respectfully submitted that in view of the foregoing all of the pending claims are patentable over the cited prior art references, alone or in any combination, and the Board is respectfully requested to overturn the rejections of record and allow this application to issue.

Respectfully submitted,



Stuart A. Whittington
Appellant's Attorney
Registration No. 45,215
(480) 715-3895

Date: October 18, 2006

APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537

APPENDIX A
(Claims on Appeal)

1. A timepiece comprising:

a casing;

a display device secured by the casing; and

a clip pivotally attached to the casing; and

wherein the clip is configured to be attachable to an object of interest and wherein the clip is configured to pivot in a position to maintain the display device in a substantially upright position when the attachment section is placed on a substantially horizontal surface.

2. The timepiece of claim 1 wherein the display device comprises a watch module.

3. The timepiece of claim 2 wherein the watch module includes a time mode and one or more modes selected from a group consisting of an altimeter mode, a compass mode, a barometer mode, an alarm mode and a chronograph mode.

4. The timepiece of claim 1 wherein the clip comprises a carabiner clip.

5. The timepiece of claim 2 further comprising a temperature sensor coupled to the watch module and wherein the display device is operable to display a temperature.

6. An attachable display apparatus comprising:

a casing configured to hold an electronic device having a display; and

a stand coupled to the casing, the stand having at least a portion thereof formed as a clip and configured to attach and detach with an object of interest;

wherein the casing and the stand are coupled such that they move with respect to each other and can be configured to lie essentially in the same plane to form a

APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537

APPENDIX A
(Claims on Appeal)

first configuration and can be configured to form an angle of ninety degrees or less between the stand and the casing to form a second configuration.

7. The apparatus of claim 6 further comprising the electronic device.

8. The apparatus of claim 7 wherein the electronic device comprises a watch module that includes a time mode and one or more modes selected from the group consisting of an altimeter mode, a compass mode, a barometer mode, an alarm mode and a chronograph mode.

9. The apparatus of claim 6 wherein the clip comprises a carabiner clip.

10. The apparatus of claim 8 further comprising a temperature sensor coupled to the watch module and wherein the watch module is operative to display an ambient temperature.

11. The apparatus of claim 7 wherein the electronic device comprises one selected from a group consisting of a MP3 player, a multi-function display device, a cell phone, a personal digital assistant, a calculator, and a digital camera.

12. The apparatus of claim 6 further comprising a hinge section configured to connect the stand with the casing in a pivoting manner.

13. The apparatus of claim 7 wherein the electronic device includes a multi-function module configured to identify and display an altitude, a temperature, a time a date, and a compass heading.

**APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537**

**APPENDIX A
(Claims on Appeal)**

14. The apparatus of claim 6 wherein the second configuration maintains the display in an upright position while the stand is placed on a substantially horizontal surface.

15. The apparatus of claim 7 wherein the electronic device is a radio communication device.

16. An apparatus comprising:
an electronic device having a display;
a casing configured to hold the electronic device; and
a clip pivotally attached to the casing, the clip configured to be attachable to an object of interest, the clip configured to be pivoted to form a stand for the apparatus.

17. The apparatus of claim 16 wherein the electronic device comprises a watch.

18. The apparatus of claim 16 wherein the electronic device comprises an altimeter.

19. The apparatus of claim 16 wherein the electronic device comprises a personal audio device.

20. The apparatus of claim 16 wherein the electronic device comprises a radio communication device.

21. The apparatus of claim 16 wherein the electronic device comprises a digital camera.

APPELLANT'S BRIEF
U.S. Appln. No. 10/719,537

APPENDIX A
(Claims on Appeal)

22. The apparatus of claim 16 wherein the electronic device comprises a calculator.

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537
Atty. Docket 50065.00011

APPENDIX B
(Evidence Appendix)

There is no additional evidence relied upon in this Appeal.

APPELLANT'S BRIEF
U.S. Appl. No. 10/719,537
Atty. Docket 50065.00011

APPENDIX C
(Related Proceedings Appendix)

There are no proceedings or decisions related to this Appeal.